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No. 04-1350

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IN THE

Supreme Court of the United States

KSR INTERNATIONAL CO.,
Petitioner,

v.

TELEFLEX INC. ET AL.,
Respondents.

On Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

SUPPLEMENTAL BRIEF FOR THE RESPONDENTS

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SUPPLEMENTAL BRIEF FOR THE RESPONDENTS

Pursuant to Supreme Court Rule 25.5, respondents respectfully submit this Supplemental Brief to address intervening materials that were not available in time to be included in respondents' Brief on the Merits. Specifically, contemporaneously with respondents' merits brief, more than twenty briefs *amici curiae* were filed supporting respondent. Inevitably, the briefs of respondents' *amici*, like petitioner's *amici*, overlap in significant respects. But in contrast to petitioner, which is able to use its Reply Brief to provide this Court with a guide to the most important points made by the briefs of its supporting *amici*, respondents can only do so through this non-argumentative Supplemental Brief. A listing of the abbreviations for the *amicus curiae* briefs appears as an Appendix.

BRIEFING IN SUPPORT OF THE EXISTING SUGGESTION STANDARD

The suggestion standard is a flexible inquiry that considers a broad range of factors:

AIPLA 13-15, 20-23; B&L Profs 2-12; DC Bar 9-12; Fallbrook 12-15; Ford, 8-12

The suggestion standard follows from this Court's precedents:

3M 21-25; AIPLA 8-12; PhRMA 12-15

The suggestion standard is consistent with § 103 of the Patent Act:

B&L Profs 13-20; FCBA 12-13; IPO 3-6

The suggestion standard addresses the inventive choice in which preexisting prior art is "merely" combined in novel ways:

Fallbrook 3-5; Michelin 16-17; PhRMA 22-25

The suggestion standard is more fair, predictable, and administrable than alternatives:

empirical studies: B&L Profs 28; Tessera 11-12
perspective of academics: B&L Profs 26-30; C&B Profs 6-7
perspective of industry: 3M 9-12; BIO 18-21, 26-30; NYIPLA 22-23
perspective of practicing lawyers: ABA 8-9
perspective of PTO: Benson 3-5; IPLAC 4-6

The suggestion standard is necessary to address hindsight bias:

3M 12-16, 26; Altitude 17-19; B&L Profs 21-25; NYIPLA 16-19

The suggestion standard creates a factual record that facilitates appellate review:

3M 11; Universities 18

BRIEFING RESPONDING TO PROPOSED ALTERNATIVE STANDARDS FOR DETERMINING OBVIOUSNESS

The Petitioner's "capability" standard:

is inconsistent with this Court's precedents: Altitude 23-24; Michelin 21-24; PhRMA 22-25
is inconsistent with § 103: Fallbrook 6-7; Michelin 22; PhRMA 25
improperly invites hindsight analysis: B&L Profs 24
would weaken patent protections and innovation: Altitude 24; PhRMA 22-25
would effectively repeal the presumption of validity for issued patents embodied in 35 U.S.C. § 282: Altitude 27

The Petitioner's "synergy" standard:

is inconsistent with this Court's precedents: AIPLA 26-28; IPO 12-14; Michelin 17-21

is inconsistent with § 103: C&B Profs 10-11; IPO 14-15; Michelin 15-17; PhRMA 26-30

is unworkable and fails to provide adequate guidance to participants in the patent system: AIPLA 27-28; BIO 25; C&B Profs 12-14

improperly invites hindsight analysis: Tessera 14-15

would weaken patent protections and innovation: C&B Profs 14-16; Fallbrook 3-5, 9-10; IPO 14

would effectively repeal the presumption of validity for issued patents embodied in 35 U.S.C. § 282: Fallbrook 6; Tessera 13-14; Universities 18-20

The Solicitor General's "extraordinary innovation" standard:

is inconsistent with this Court's precedents: 3M 26; BIO 23 n.8

is inconsistent with § 103: AIPLA 28-29; Fallbrook 6-7; IPO 15

is unworkable and fails to provide adequate guidance to participants in the patent system: 3M 26

effectively repeal the presumption of validity for issued patents embodied in 35 U.S.C. § 282: AIPLA 29

Changing the prevailing suggestion standard would destabilize the patent system:

general industry: 3M 16-18; Fallbrook 7-12

specific industries: BIO 5-10, 26-30; Michelin 25-28; Tessera 16-29

OTHER ARGUMENTS RAISED BY *AMICI CURIAE*

Background to the history and purpose of § 103 of the Patent Act:

BIO 11-15; NYIPLA 4-12; PhRMA 5-8

The Federal Circuit and its predecessor have consistently applied the suggestion standard for over 60 years:

Altitude 20; FCBA 14; Tessera 4-6

The suggestion standard is a product of the Federal Circuit's unique role in implementing this Court's decision in *Graham*:

FPLC 18-21

To the extent that the well-settled suggestion standard requires revision, Congress is the appropriate body to make any significant changes:

ABA 9-10; Thomason 12-17; TPL 5

To the extent that patent law has problems, the suggestion standard is not responsible for them:

Altitude 28-30; Ford 15-16; Hollaar 12-20

Under established standards of appellate review, the Federal Circuit properly reversed the district court's summary judgment order:

Thomason 7-12; UIA 9-12, 17-20

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted,

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APPENDIX

ABBREVIATIONS FOR *AMICI CURIAE* BRIEFS

3M = 3M Co. et al.

ABA = American Bar Association

AIPLA = American Intellectual Property Law Association

Altitude = Altitude Capital Partners et al.

B&L Profs = Business and Law Professors

Benson = Christopher R. Benson et al.

BIO = Biotechnology Industry Organization

C&B Profs = Chemistry and Bioengineering Professors

DC Bar = Bar Association of the District of Columbia – Patent, Trademark & Copyright Section

Fallbrook = Fallbrook Technologies, Inc. et al.

FCBA = Federal Circuit Bar Association

Ford = Ford Motor Co. & DaimlerChrysler Corp.

FPLC = Franklin Pierce Law Center, Intellectual Property Amicus Clinic

Hollaar = Professor Lee A. Hollaar

IPLAC = Intellectual Property Law Association of Chicago

IPO = Intellectual Property Owners Association

Michelin = Michelin North America, Inc. et al.

NYIPLA = New York Intellectual Property Law Association

PhRMA = Pharmaceutical Research and Manufacturers of America

Tessera = Tessera, Inc. et al.

Thomason = Lee Thomason

TPL = Technology Properties Ltd.

UIA = United Inventors Association

Universities = Wisconsin Alumni Research Foundation et al.